

REMARKS

Review and reconsideration on the merits are requested.

The Rejections

At the time of the Action, the following rejections were posed:

Claims 21-23, 25 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Matsuoka et al (U.S. Patent No. 5,384,236).

Claims 21-23, 25 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Nagaoka et al (U.S. Patent No. 5,460,929).

Claims 21-23, 25 and 27 were rejected under 35 U.S.C. § 102(b) as being anticipated by Mihayashi et al (U.S. Patent No. 5,543,282).

Claim 26 was “provisionally rejected” as obvious over JP 2000-181002; JP 11-119364; JP 51-59943; JP 54-32552; and JP 2001-133931.

Traversal of Art Rejections

First, Applicants amend claims 21 to call for a method of increasing speed of a silver color halide photosensitive material containing a main coloring coupler by adding to the silver halide photosensitive material 5-100mg/m² of at least one type of compound other than main coloring coupler.

The color coupler called for in claim 21 has a coloring property as it main function. In distinction, the compound represented by general formula (C) is not added as compound having a coloring property as its main function, although it has some coloring property. Applicants clearly differentiate these components from each other by adding the word “main” to the coloring coupler.

Support occurs as follows.

The use of the coloring coupler in the photosensitive material of the present invention is disclosed at page 64, lines 21-23.

The specific embodiment of claim 21 as amended is presented in the Example.

Claims 21 and 29 are combined. As a consequence, claim 29 is canceled.

The Examiner points out that there is no support in the specification which indicates that the compound of general formula (C) does not have a coloring property. Applicants advise that the arguments were meant to express the following.

The main feature of the present invention is that an ordinary “main” coupler is added to a photosensitive material, and, further, a specific amount ($5\text{-}100\text{mg/m}^2$) of the compound of general formula (C) is added thereto, thereby increasing the speed of the photosensitive material. It must be noted that the amount of the main coloring coupler added, $5\text{-}100\text{mg/m}^2$, is far less than the amount of an ordinary coupler usually added.

In contrast to the present invention, in Matsuoka, Nagaoka and Mihayashi a compound that is within general formula (C) is used. However, the amount of the compound within general formula (C) used in the Examples of these three patents is far greater than the amount specified in the present claims. The reason for that is that in each of these three patents the compound which falls within formula (C) is used as the main coloring coupler. Thus, none of these three patents disclose or suggest that the speed of a photosensitive material can be increase **with a far lesser amount of a coupler** as in the present invention.

Withdrawal of the art rejections is requested.

Paragraph V of the Action

Applicants are aware of no authority for an Examiner to find that a teaching and suggesting in the prior art “may be sufficient to applied against it [speaking of claim 26] as that on the record in the foreign Office Action as submitted...”

Applicants are due a fair statement of the Examiner’s position. Either the claim should be rejected or the claim should not be rejected.

It is improper for the Examiner to shift to Applicants the burden of making rejections against the claims.

Paragraph VII of the Action

See the above discussion regarding Paragraph V. The Examiner should either reject the claims or not reject the claims. If prior art is available as statutory prior art, the claims are properly rejected over such prior art or not properly rejected over such prior art.

Applicants advise that they have, however, reviewed the references and are of the opinion that the references are not relevant to the present claims.

That should put any type of “possible” or “provisional” rejection to rest.

If the Examiner disagrees, the Examiner is requested to contact the undersigned at the later given telephone exchange.

The Examiner’s attention is directed to the information disclosure statement filed September 25, 2006. Applicants request that an initialed copy of PTO/SB/08 be promptly returned the Examiner.

AMENDMENT UNDER 37 C.F.R. §1.111
U.S. Application No. 10/809,912

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

/Peter D. Olexy/
Peter D. Olexy
Registration No. 24,513

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: December 19, 2006